

## **REMARKS**

### **I. Status of the Claims**

Upon entry of this amendment, claims 1, 3-11, 13-14, 19-20, 24-37 and 39-40 will be pending. Claims 2, 12, 15-18, 21-23, 38 and 41-52 have been canceled without prejudice or disclaimer. Applicants reserve the right to pursue one or more of these claims in one or more continuation applications. As claims 3-10, 16-19 and 24-47 were previously withdrawn by the Examiner, claims 1, 11, 13-14 and 20 are currently at issue. Claim 1 has been amended to no longer call for an optional substituent. Claims 14 and 20 have been amended to correct typographical errors. Claims 3, 5-9, 13 and 24-37 have been amended to insert a comma before the term "wherein." No new matter has been added by way of this amendment.

### **II. August 10, 2009 Advisory Action**

In the August 10, 2009 Advisory Action, the Examiner indicated that claims 1, 11, 13 and 20, drawn to the isolated and enabled claims, may be allowable. Applicants note that claim 14 is also drawn to the isolated compound, and specifies the amount of isolated active ingredient. The difference between claims 13 and 14 is the amount of isolated active ingredient present in the composition. Claims 13 and 14 are supported on at least at p. 5 (claim 13) and p. 8 (claim 14) of the application as filed.

### **III. Interviews with Examiner Desai**

Applicants' representative (Joshua Marcus) thanks Examiner Desai for the courtesy extended in discussing the current Office Action in the telephone interviews conducted on June 17, 2009 and June 30, 2009. In the first interview, Applicants' representative stated that claim 12 was mistakenly withdrawn. Additionally, in the previous Office Action (mailed September 25, 2008), claims 2, 12 and 21-23 were allowed. Applicants' representative noted that claims 2, 12 and 21-23 were not amended in response to the September 25, 2008 Office Action; and that no reasons were given in the present Office Action for rejection of any of claims 2, 12 and 21-23. Accordingly,

Applicants' representative reasoned that these claims should still be allowed. Examiner Desai agreed that claim 12 should be pending and that claims 2, 12, and 21-23 appeared to be allowable. However, the Examiner would not confirm during the interview that these claims were in fact, allowable.

Applicants' representative (Joshua Marcus) called Examiner Desai on June 30, 2009 to inquire further about the enablement rejection. Specifically, Applicant's representative was unclear as to why the enablement rejection was issued in the present Office Action, when in the September 25, 2008 Office Action, the Examiner stated in an enablement rejection for use of the term solvates:

Hence, applicants must show that solvates can be made, or limit the claims accordingly.

(September 25, 2008 Office Action, p. 3). In response to the September 25, 2008 Office Action, without conceding the validity of the rejection, and in order to advance prosecution, Applicants deleted the term "solvates" from the claims. However, the enablement rejection for use of the term "solvates" was issued again in the present Office Action. After bringing these facts to the Examiner's attention, the Examiner withdrew the enablement rejection for use of the term "solvates."

#### **IV. Enablement Rejection**

Claims 1, 11, 13, 14 and 20 are rejected under 35 U.S.C. §112, first paragraph, as lacking enablement, because in the Examiner's view, an isolated compound cannot be optionally substituted (*see* Office Action, p. 2). Applicants have amended these claims to delete the phrase "positions 1, 4, 5, and 8 are optionally substituted with halogen, amine, amino, imino, carboxylic acid or amide." Accordingly, this rejection appears to be moot.

Additionally, the Examiner stated in the August 10, 2009 Office Action that claims 1, 11, 13 and 20 are enabled, as follows:

Claims 1, 11, 13 and 20, drawn to the isolated and enabled claims,  
may be allowable.

(Advisory Action, p. 2, underlining added).

Applicants note that the rejection on p. 3 of the Office Action states the “*previous rejection under 35 U.S.C. §112 first paragraph over enablement of solvates, anhydrides, tautomers and salts still stands over claims 1, 11, 13, 14 and 20.*” However, the rejection goes on to discuss only “solvates.” As conceded by the Examiner in the June 30, 2009 interview summary, the rejection over the term “solvates” was made in error and has been withdrawn.

The Examiner then states that the reagents taught on pp. 11–12 of the specification cannot form all the salts, solvates and anhydrides of the claimed compounds. However, the Examiner fails to recognize that pp. 6–7 of the specification provide ample guidance to one of ordinary skill in the art regarding the reagents and processes for forming salts of the present invention. The Examiner appears to be interpreting the claims to mean that salts have to be isolated from ascidian. However, claim 1 does not call for salts to be isolated from ascidian, each calls for salts of an isolated compound (*i.e.*, “salts thereof”). Hence, the salts can be formed after isolation of the free compound.

The Examiner has not made an argument or offered any reason as to why one of ordinary skill in the art would not have been able to make the salts of the compounds of claim 1, after isolation of the free compound, without undue experimentation. Nor has the Examiner provided a reasonable explanation as to why tautomers and anhydrides of the compounds of claim 1 are not adequately enabled (*see* MPEP §2164.04). As such, the Examiner has not met her burden in establishing a *prima facie* case against the rejected claims for lack of enablement of tautomers and anhydrides of the compounds of claim 1.

As stated in the March 25, 2009 response, and reiterated herein, Applicants’ position is that one of ordinary skill in the art would have readily known how to make and use tautomers and anhydrides of the present invention. As a general matter, the level of skill in the chemical arts is

high. Typically, the ordinary skilled artisan is a Ph.D. chemist with 2–3 years experience. The most basic form of tautomerization, keto–enol tautomerization, is taught in undergraduate organic chemistry classes. For the Examiner's reference, an undergraduate level organic chemistry textbook excerpt, describing how to perform such a reaction, is submitted herewith as Exhibit 1.<sup>1</sup> Graduate level organic chemistry texts teach other mechanisms of tautomerization (see Exhibit 2).<sup>2</sup> Accordingly, the tautomerization reactions set out in Exhibits 1 and 2 are within the skill of the ordinary skilled organic chemist.

By the same reasoning, one of ordinary skill in the art would have readily known how to form anhydrides of the claimed compounds of the present invention. As stated above, the ordinary skilled chemist is typically a Ph.D. with 2–3 years experience. Graduate level organic chemistry texts provide great detail as to how to form various anhydrides, depending on a molecule's atomic structure. For the Examiner's convenience, an excerpt from a graduate level organic chemistry textbook is submitted herewith, as Exhibit 3.<sup>3</sup> Exhibit 3 clearly shows that multiple methods of anhydride formation are taught to organic chemistry graduate students. Accordingly, one of ordinary skill in the art would have known how to form the claimed anhydrides of the present invention.

For at least these reasons, Applicants requests withdrawal of the enablement rejection and reconsideration of the claims.

#### V. Written Description Rejection

Claims 1, 11, 13, 14 and 20 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner argues that the specification does not have the written description for the clause "*positions 1, 4, 5, and 8 are optionally substituted with halogen, amine, amino, imino, carboxylic acid or amide.*" Without conceding the validity of the rejection, and in order to advance prosecution, this clause has been deleted from the rejected

<sup>1</sup> Exhibit 1 published in 1999, which is approximately five years before the present application's filing date (2004).

<sup>2</sup> Exhibit 2 published in 1992, which is approximately twelve years before the present application's filing date (2004).

<sup>3</sup> Exhibit 3 published in 1992, which is approximately twelve years before the present application's filing date (2004).

claims. Accordingly, the written description rejection over claims 1, 11, 13, 14 and 20 appears to be moot. Applicants therefore request withdrawal of the written description rejection and reconsideration of the claims.

### CONCLUSION

Based on the above amendments and arguments, the subsisting claims are believed to be in condition for allowance, and such action is earnestly solicited. If there are remaining issues that the Examiner believes could be addressed by conducting an interview or entering an Examiner's Amendment, the Examiner is cordially invited to contact the undersigned agent to discuss such issues.

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Respectfully submitted,

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### **Enclosures**

- Exhibit 1 – 7 pages
- Exhibit 2 – 7 pages
- Exhibit 3 – 3 pages